

The opinion in support of the decision being entered today was not written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY DEAN WALKER

Appeal No. 2002-0791
Application 08/883,710

ON BRIEF

MAILED

JAN 15 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before JERRY SMITH, FLEMING, and RUGGIERO, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

REMAND TO EXAMINER

We remand this application to the Examiner for consideration of the following matters.

On page 4 of the Examiner's answer, the Examiner sets forth a rejection of claims 1 through 19 as being anticipated by Ellis under 35 U.S.C. § 102. For the independent claims 1, 7 and 17, the Examiner broadly addresses the method steps set forth in

Appellant's independent claim 1. However, the Examiner does not address the limitations of independent claims 7 and 17 separately. Furthermore, even for the independent claim 1, the Examiner has not made clear exactly what teachings in Ellis are being relied on for each of the claimed limitations set forth in claim 1.

In particular, the Examiner quotes Appellant's claimed limitation, "selectively receiving a first response in response to transmission of the first information frame" and simply provides brackets with reference to Ellis as column 2, lines 5 through 35. However, it is not clear what teaching in Ellis that the Examiner is relying on for the "a first response" and the "first information frame" as recited in this method step recited in Appellant's claim 1.

Similarly, the Examiner simply quotes the next method step recited in Appellant's claim 1, "measuring a first amount of time between transmission of the first information frame and receipt of the first response," and then simply provides brackets with presumably a reference to Ellis of column 2, lines 36 through 65. However, the Examiner has not made clear exactly what teaching in Ellis is being relied on for the claim limitation "a first amount of time."

Similarly, the Examiner quotes the next method step recited in Appellant's claim 1, "selectively modifying a response time value in response to the first amount of time," and then provides brackets with reference to column 6, lines 29 through 58. However, it is not clear what teaching in Ellis is being relied on for the claim limitation "a response time value." The Examiner further quotes the Appellant's claim 1 limitation, "wherein said step of measuring a first amount of time between transmission of the first information frame and receipt of the first response uses a timer operating in response to a clock, and wherein said response time value is a response time value of said timer" and then points us to column 5, lines 25 through 40 and 56 through 62. However, the Examiner has not made clear as to exactly what teaching in Ellis teaches this limitation. In particular, column 5 and column 6 of Ellis direct us to figure 3 and figure 4. Figure 3 show a database 80 having columns 91, 92, 93, 94 and 95. The Examiner has not made clear which of these columns in this database that the Examiner is relying on for the teaching of a response time value. Appellant is equally confused in that the Appellant assumes that the Examiner is relying on column 95 which stores a value that keeps track of successful response from the network device. See page 3 of the supplemental

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brief. However, from the Examiner's rejection it is not clear that the Examiner is relying on column 95. The Examiner could be relying on column 93 which stores a value of the current calculated time used between retries or the Examiner could be relying on column 92 which stores the value of maximum response time. The record is just not clear as to how the Examiner is reading the Ellis reference on the limitations recited in claim 1.

Our reviewing court requires that

[t]he Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability.

In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002)

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. See **In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." **RCA Corp. v. Applied Digital Data Sys., Inc.**, 730

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F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed,
486 U.S. 1228 (1994), citing **Kalman v. Kimberly-Clark Corp.** 713
F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

We request that the Examiner clearly point out how each of the claim limitations recited in claims 1, 7 and 17 are met by the references in one-to-one correspondence. For each claim limitation, the Examiner must point to specific portions of the reference on which the Examiner is relying to meet that limitation. It is the Examiner's duty to make pertinent and specific factual findings, including the scope of the claims as well as the content of the prior art. On remand, the record needs to be clarified as to the Examiner's position on how the claimed subject matter is met by the prior art.

Appellant has argued that the prior art does not disclose "measuring a first amount of time between transmission of the first information frame and receipt of the first response uses a timer operating in response to a clock, and wherein said response time is a response time value of said timer," as recited in claim 1. The Examiner responds by saying that it is obvious that the timer or clock has been used to measure the maximum time frame for sending a request and calculate a response time from the network device. See page 6 of the Examiner's answer.

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The Examiner should clarify whether the rejection is based on 35 U.S.C. § 102 or is based upon 35 U.S.C. § 103.

"Inherency and obviousness are distinct concepts." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1555, 220 USPQ 303, 314 (Fed. Cir. 1983) citing In re Spormann, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966). Furthermore, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) citing Continental Can Co v. Monsanto Co., 948 F.3d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. citing Continental Can Co. v. Monsanto Co., 948 F.3d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

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The Examiner must make clear whether the Examiner is relying on obviousness or inherency. If the Examiner is relying on inherency, the Examiner must provide evidence which makes clear that the missing descriptive matter, the timer, is necessarily present in the Ellis system.

This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMAND

Jerry Smith

JERRY SMITH
Administrative Patent Judge

Michael R. Fleming
MICHAEL R. FLEMING
Administrative Patent Judge

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge

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